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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,224	02/06/2001	Samuel A. Marquiss	LJL 34602	5738

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EXAMINER
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HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/778,224

Applicant(s)

MARQUISS ET AL.

Examiner

Dwayne K Handy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6, 8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) 7 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-5. 6) ☐ Other: .

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4 and 5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 4 and 5 do not further limit the system. Applicant appears to be placing limitations on elements that are not part of the apparatus. In claim 1, applicant has claimed an apparatus for stacking and unstacking microplates. Applicant has not actually claimed any microplates in the claim. Therefore, the limitations of claims 4 and 5 do not place any further limitations on the apparatus.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, 5, 10-16, and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kercso et al. (6,495,369). Kercso teaches a high throughput system for

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analyzing samples stored in microplates. The system is best shown in Figure 1 and described in columns 7 and 8. The system (10) manipulates samples in microplates (12) and includes an input stack (16) and output stack (18) connected by a conveyor system (14) that operates between the two stacks and in a direction that is perpendicular to the stacking direction used by the stacking stations. The system also includes a dilution station (24) for dispensing sub-microliter amounts of liquids through pipette arrays to the plates (column 8, lines 41-67 and column 11, line 35 – column 12, line 24). An optical detection system is also included for analyzing samples (column 13, line 54 – column 14, line 43) as well as a controller (column 16) for automated control.

4. Claims 1-6, 10-16, and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Stylli et al. (6,472,218). Stylli shows a system for storing and screening compounds in microplates. The overall system is shown in Figures 3-5 and includes a sample dispensing module (described in columns 11-15), an analyzer (columns 21-26) and storage and retrieval modules (columns 9-10). The storage and retrieval modules containing stacked microplates are described in Example 2 and include a lifter and a plurality of pins capable of receiving and releasing the plates as well as manipulating the lids. Figure 4 shows a transport system for moving plates between stacking units.

5. Claims 1-6, 8, 10, 11, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Modlin et al. (6,469,311). Modlin shows a system for storing and optically analyzing samples in microplates. The overall system is best shown in Figure 44 and

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described in columns 28-39. The overall system includes two stacking units (824, 826), transporter (814), control unit (810), and an optical detector. The unit includes a sample feeder (948) which is described in columns 35-37. The sample feeder includes an input station (950) and output station (954), both of which employ latches and lifters to manipulate the stacks of microplates. The optical elements are described in detail in columns 10-18.

6. Claims 1, 4, 5, 10-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Shtrahman et al. (6,402,837). Shtrahman teaches a robotic system for performing microplate feeding, liquid aspiration and dispensing, as well as microplate sealing and storage. The system is best shown in Figure 1 and described in columns 2 and 3. Empty microplates are transferred from magazine (10) along a path to a dispenser probe (20) and then to a storage hotel (11).

#### ***Allowable Subject Matter***

7. Claims 7 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Astle (6,274,374) shows a combination stacker/incubator for

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microplates. Lenz (6,351,690) teaches an automated system for drug screening in microplates. Shumate et al. (6,372,185) teach a liquid distribution system with elements for storing microplates in a stacked configuration. Kedar et al. (6,323,035) show a system for handling microplates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (703)-305-0211. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703)-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

Dkh  
December 15, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700